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10/022,479	12/17/2001	Domingo Rohde	81,485/LPK	2759

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EXAMINER

NOTE, JANIS L

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,479

Applicant(s)

ROHDE et al

Examiner

J. DOTE

Group Art Unit

1756

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 3/12/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) 1-11 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 12-14, 16-19, 21, 22 is/are rejected.
- ☒ Claim(s) 15, 20 is/are objected to.
- ☒ Claim(s) 1-22 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-11, drawn to a digital image recording process to form a color image, classified in class 430, subclass 47.

II. Claims 12-22, drawn to a toner, classified in class 430, subclass 105.

2. The inventions are distinct, each from the other because:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in a materially different process, such as a process to form a monochrome image, comprising the steps of developing an electrostatic latent image on a support with the toner of Group II and fixing the developed on the support.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and as shown by their

different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Lawrence Kessler on Apr. 22, 2003, a provisional election was made without traverse to prosecute the invention of Group II, claims 12-22.

Affirmation of this election must be made by applicants in replying to this Office action. Claims 1-11 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The information disclosure statement filed in Paper No. 4 on Dec. 17, 2001, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information,

of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

(1) In claim 16, the recitation "the toner contains a combination of different colored particles" lacks antecedent basis in the specification. See page 5, lines 1-3, of the specification, which discloses that "the color black is formed or formed together with at least one toner layer that contains a combination of different color pigment particles" (emphasis added). The specification does not disclose a toner containing a combination of different color pigment particles as recited in instant claim 16.

(2) In claim 17, the recitation "the toner contains a combination of different colored particles that are provided to produce the colors cyan, magenta, and yellow " lacks antecedent basis in the specification. See page 5, lines 1-5, of the specification, which discloses that "the color black is formed or formed together with at least one toner layer that contains a combination of different color pigment particles . . . that are

usually used for the colors cyan, magenta, and yellow" (emphasis added). The specification does not disclose a toner containing a combination of different color pigment particles as recited in instant claim 17.

(3) In claim 18, the recitation "it [the toner] has no carbon black" lacks antecedent basis in the specification. See page 5, lines 7-8, of the specification, which discloses that the color black is formed or formed together with at least one toner layer that is not pigmented with carbon black" (emphasis added). The specification does not disclose a toner containing no carbon black as recited in instant claim 18.

(4) In claim 19, the recitation "it [the toner] contains a portion of carbon black of less than 2%" lacks antecedent basis in the specification. See page 5, lines 13-15, of the specification, which discloses that the color black is formed or formed together with at least one toner layer that has a carbon black portion of less than 2%" (emphasis added). The specification does not disclose a toner containing carbon black as recited in instant claim 19.

(5) In claim 20, the recitation "it [the toner] contains neutral grey pigments" lacks antecedent basis in the specification. See page 5, lines 25-26, of the specification, which discloses that the color black is formed or formed together with at least one toner layer that contains neutral grey pigments

free from carbon black portion" (emphasis added). The specification does not disclose a toner containing neutral grey pigments as recited in instant claim 20.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 19, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is indefinite in the phrase "it [i.e., the toner] contains a portion of carbon black of less than 2%" because it is not clear what is the basis of the percentage (e.g., weight, volume, etc.). The claim and the specification do not identify the basis of said percentage.

Claim 21 recites that the toner "is formed by several toner layers with different colors after it is transferred onto the image receiving substrate" (emphasis added). A toner is usually defined as colored particles. See the instant specification, page 1, lines 13-16. It is not clear how a toner that comprises toner particles is formed from toner layers after transferring

the toner onto an image receiving substrate. The phrase is further indefinite for lack of unambiguous antecedent basis for "the image receiving substrate" in claim 13. Claim 13, which depends from claim 12, recites that the toner is provided for the purpose of being fused . . . and fixed onto an image carrier substrate," not an image receiving substrate.

Claim 22 is indefinite in the phrase "the toner layers with different colors contain the colors cyan, magenta, and yellow" (emphasis added) for lack of unambiguous antecedent basis in claim 13. Claim 13 recites a toner. Claim 13 does not recite the presence of toner layers.

9. The examiner has interpreted the percentage "less than 2%" recited in instant claim 19 as a weight percentage and based on the total weight of the toner. Rejections based on this interpretation are set forth infra.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 12-14 and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,149,610 (Kobayashi).

Kobayashi discloses a black toner comprising a polyester binder resin and a mixture of a cyan pigment, a magenta pigment, and a yellow pigment. See example 1 at cols. 21-22, and col. 22, lines 11-13. The black toner meets the compositional limitations recited in instant claims 16-19. Kobayashi discloses that the black toner has a spectral reflectance of about 80% in a wavelength region of 800 to 1000 nm (i.e., 0.8 to 1.0 μ m). See Fig. 5, and col. 22, lines 53-56. In other words, the black toner absorbs about 20% of the energy when irradiated with light having a wavelength in the wavelength region of 800 to 1000 nm. The wavelength region of 800 to 1000 nm is within the range recited in instant claims 13 and 14. The spectral reflectance of the black toner is similar to those of the magenta toner, the yellow toner, and the cyan toner. See Fig. 5. Thus, the black toner has absorption properties similar to those of the other color toners when irradiated with light having a wavelength in the wavelength region of 800 to 1000 nm. Accordingly, the black toner meets the limitation of having "similar absorption properties during irradiation with electromagnetic radiation with at least one wavelength out of a predetermined wavelength range, as other toners . . . [that] produce colors other than black" recited in instant claim 12.

Kobayashi does not disclose that its black toner is "provided for the purpose of being fused by electromagnetic radiation and fixed onto an image carrier substance" as recited in the instant claims. However, as discussed above, Kobayashi meets the compositional limitations and absorption characteristics recited in the instant claims. The recitation is a statement of intended use, which does not distinguish the recited toner composition from the black toner disclosed by Kobayashi.

12. Claims 15 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not disclose or suggest a toner as recited in instant claim 15. As discussed in paragraph 11 above, Kobayashi teaches a black toner that absorbs about 20% of the energy when irradiated with light having a wavelength in the wavelength region of 800 to 1000 nm. However, Kobayashi does not teach or suggest a black toner absorbing "less than 10% of the energy" when "irradiated with electromagnetic radiation with wavelengths in the IR range below approximately 5 μm " as recited in instant claim 15.

The prior art of record does not disclose or suggest a black toner comprising "neutral grey pigments" as recited in instant claim 20.

13. The papers (i.e., oath/declaration filed on Mar. 12, 2002 have not been made part of the permanent records of the United States Patent and Trademark Office (Office) for this application (37 CFR 1.52(a)) because of damage from the United States Postal Service irradiation process. The above-identified papers, however, were not so damaged as to preclude the USPTO from making a legible copy of such papers. Therefore, the Office has made a copy of these papers, substituted them for the originals in the file, and stamped that copy:

COPY OF PAPERS
ORIGINALLY FILED

If applicant wants to review the accuracy of the Office's copy of such papers, applicant may either inspect the application (37 CFR 1.14(d)) or may request a copy of the Office's records of such papers (i.e., a copy of the copy made by the Office) from the Office of Public Records for the fee specified in 37 CFR 1.19(b)(4). Please do **not** call the Technology Center's Customer Service Center to inquiry about the completeness or accuracy of Office's copy of the above-identified papers, as the Technology Center's Customer Service Center will **not** be able to provide this service.

If applicant does not consider the Office's copy of such papers to be accurate, applicant must provide a copy of the above-identified papers (except for any U.S. or foreign patent documents submitted with the above-identified papers) with a statement that such copy is a complete and accurate copy of the originally submitted documents. If applicant provides such a copy of the above-identified papers and statement within **THREE MONTHS** of the mail date of this Office action, the Office will add the original mailroom date and use the copy provided by applicant as the permanent Office record of the above-identified papers in place of the copy made by the Office. Otherwise, the

Office's copy will be used as the permanent Office record of the above-identified papers (i.e., the Office will use the copy of the above-identified papers made by the Office for examination and all other purposes). This three-month period is not extendable.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (703) 308-3625. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311 (Rightfax) for after final faxes, and (703) 872-9310 for other official faxes.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Palestine Jenkins, whose telephone number is (703) 308-3521.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

JLD
April 24, 2003

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1530
(703)